

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner withdraws all of the previous rejections of the claims with the exception of the rejection of claims 29 and 31. However, the Examiner makes new rejections for the other claims using newly found references. Specifically, the Examiner now rejects claims 1, 4 and 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,540,433 to Brockman (hereinafter "Brockman"). Additionally, the Examiner now rejects claims 1 and 2 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,604,980 to Jurmain et al., (hereinafter "Jurmain"). Furthermore, the Examiner now rejects claims 1, 4, 5 and 12 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,640,355 to Samide (hereinafter "Samide"). Still further, the Examiner now rejects claim 10 under 35 U.S.C. § 103(a) as being unpatentable over either Samide or Brockman in view of U.S. Patent No. 4,445,235 to Slover et al., (hereinafter "Slover"). Lastly, the Examiner repeats the rejection of claims 29 and 31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,632,175 to Marshall (hereinafter "Marshall").

In response, claim 1 has been amended to recite that the medical capsule retrieval device comprises a detector for detecting a medical capsule discharged from within the human body. The amendment to claim 1 is fully supported in the original disclosure, such as at claim 1 as originally filed. Thus, no new matter has been introduced into the disclosure by way of the amendment to claim 1.

With regard to Brockman, the Examiner argues that the same discloses a feces strainer that can have more than one layer and each layer can have a different size aperture so as to separate the semi-solid feces from the solid feces. With regard to Jurmain, the Examiner

appears to argue that a diaper is capable of catching a capsule endoscope. With regard to Samide, the Examiner argues that the stool sample collection device disclosed therein is capable of also catching a capsule endoscope. Applicants respectfully submit that neither the feces strainer of Brockman, the diaper of Jurmain nor the stool sample collection device of Samide disclose or suggest a medical retrieval device having a detector for detecting a medical capsule discharged from within the human body.

With regard to the rejections of claims 1, 4, 5 and 12 under 35 U.S.C. §§ 102(b) and 102(e), a medical capsule retrieval device having the features discussed above and as recited in independent claim 1, is nowhere disclosed in either Brockman, Jurmain or Samide. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claim 1 is not anticipated by either Brockman, Jurmain or Samide. Accordingly, independent claim 1 patentably distinguishes over Brockman, Jurmain and Samide and is allowable. Claims 4, 5 and 10 being dependent upon claim 1 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 4, 5 and 12 under 35 U.S.C. §§ 102(b) and 102(e).

With regard to the rejection of claim 10 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claim 10 is at least allowable therewith because it depends from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 10 under 35 U.S.C. § 103(a).

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

With regard to the rejection of claim 2 under 35 U.S.C. § 102(e), the Examiner argues that Jurmain discloses the features thereof because the diaper disclosed therein is capable of catching a capsule endoscope and has a magnet (61). Applicants respectfully disagree. Firstly, since the diaper of Jurmain is not for human use, nothing is discharged from the doll into the diaper. Secondly, the magnet is not for use in catching a medical device or anything discharged from the doll, it is only used as a sensor to detect the presence or absence of the diaper on the doll. Therefore, a catch unit for catching a medical capsule discharged from within a human body and having a magnet for magnetically attracting one of a magnetic material and a magnet in the medical capsule is nowhere disclosed or suggested in Jurmain.

Claim 2 has been rewritten in independent form to include the features of claim 1. Thus, a medical capsule retrieval device having the features discussed above and as recited in independent claim 2, is nowhere disclosed in Jurmain. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"² independent claim 2 is not anticipated by Jurmain. Accordingly, independent claim 2 patentably distinguishes over Jurmain and is allowable. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 2 under 35 U.S.C. § 102(e).

With regard to Marshall and the rejection of claim 29 under 35 U.S.C. § 103(a), Applicants previously argued that although Marshall generally discloses capturing the capsule endoscope after evacuation, Marshall does not disclose a catching unit for catching the capsule endoscope. The Examiner has responded by arguing that the catching of the capsule endoscope with a catching unit is inherent in Marshall, since a person would not be

2 Id.

-11-

g:\Olympus\1494\17378\amend\17378.am2

expected to use their hands to retrieve the capsule endoscope from excrement. Thus, the Examiner considers a glove or prongs to be a catching unit. Applicants again disagree. Although gloves or prongs may be inherent from Marshall, the same would be used to recover the capsule endoscope from the excrement. Marshall does not imply that the capsule endoscope is "caught" as it is excreted from the body. To clarify such a distinction, claim 29 has been amended to clarify the step of catching the medical capsule as it is discharged from within the human body using a catch unit.

Thus, independent claim 29 is not rendered obvious by the cited references because the Marshall patent, whether taken alone or in combination with the knowledge of those of ordinary skill in the art, does not teach or suggest a retrieval method for retrieving a medical capsule having the features discussed above and recited in independent claim 29. Accordingly, claim 29 patentably distinguishes over the prior art and is allowable. Claim 31, being dependent upon claim 29, is thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 29 and 31 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicants' attorneys would be advantageous to the disposition of this case,
the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm